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#35
PATENT
P53821C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Richard G Hyatt Jr.

Serial No.: 08/720,070 Examiner: BOUCHER, D.

Field: 27 September 1996 Art Unit: 3627

For: ELECTROMECHANICAL CYLINDER PLUG

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PETITION UNDER 37 CFR §1.144

The Assistant Commissioner
of Patents
Washington, D.C. 20231

Sir:

Applicant respectfully petitions under 37 CFR §1.144 from the requirement for an Election of Species under 35 U.S.C. §121 that was made in paper No. 4 dated 17 September 1997, and as reason therefore, states that:

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STATEMENT OF FACTS

1. In paper No. 4 dated 17 September 1997, the examiner identified seven "patentably distinct species", and required applicant to elect a single disclosed species.
2. In reply, applicant elected the species E, shown in Figs. 8A-8G, inclusive, with traverse. Applicant explained the impropriety of the requirement.
3. In paper No.7 dated 7 January 1998, the examiner repeated and made final the requirement for election. In subsequent Office actions (Paper No. 25 for example, dated on the 17th of August 1999), the Examiner has held numerous claims to have been withdrawn from consideration.
4. In an office interview held with the Examiner and one of the inventors on the 17th of March 2000, the Examiner was unable to give applicant a clear determination of whether the requirement for election stood, or whether the requirement had, or will be withdrawn.
5. During the course of the examination references such as Gokcebay *et al.*, U.S. Patent No. 5,552,777 and Field *et al.*, U.S. Patent No. 5, 839, 307 have been made of record and one of these references has ever been cited by the Examiner to support an art rejection of some of the pending claims.

REMARKS

There are two reasons under 35 U.S.C. §121 for insisting upon a restriction. As explained in §808 of the *Manual of Patent Examiner Procedure*, 7th edition, July 1998,

"Every requirement to restrict has two aspects: (1) the reasons ... why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween is set forth in the following sections."

In the instant application the Examiner and applicant agreed that there are several patentably distinct inventions disclosed. Only this second reason remains in contention between the Examiner and applicant, namely the reasons given by the Examiner for insisting upon restriction. Applicant has traversed the requirement and believes that there is in fact no basis for continuing the insistence upon restriction.

The Gokcebay '777 Patent is currently classified in class 340, subclass 825.31 and class 70, subclass 278.3, among other classifications, while Field, *et al.*, '307 is currently classified solely in class 70, at subclasses 283, 276 and 495.

Applicant maintains that it is the subject matter defined by applicant's pending claims, rather than the field of the search which those claims necessitate, that determines "the reasons for insisting upon restriction" under 35 U.S.C. §121 and 37 CFR §1.146.

The mandatory search required by applicant's pending claims necessarily includes both classes 70, that is locks generally, and especially subclass 283 "wherein the automatic effect in locking condition is to prevent the movement of a manually controlled operator or manipulator, by means of a detent of the pawl or catch type", as well as class 235, registers, subclasses 382 (permitting access) and 382.5 (changeable authorization), together with class 340 (communications: electrical) subclass 382, where entry is controlled by a data bearing record. Accordingly, in view of the breath of the mandatory search, there is no basis for artificially dividing the several species disclosed and claimed in the instant application into separate applications.

RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

- A. Withdraw the requirement for applicant to make an election of species under 37 CFR §1.146;
- B. Examine all of the pending claims upon the merits; and
- C. Grant such other and further relief as justice may require.

Respectfully submitted,



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